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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORISHIGE MORIMOTO, KATASHI NAGAO,
and SEIJI KOBAYASHI

Appeal 2009-002941
Application 10/074,786
Technology Center 3600

Decided: August 26, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 3-5, 24, and 31 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to an advertising or other content distribution system that employs a system for the distribution of free content. The system provides a service for the distribution of advertisement and/or other content to users who desire to acquire the free content (Spec. 4:10-15).

Claim 3, reproduced below, is representative of the subject matter of appeal.

3. A content registration/management system comprising:

> content registration request reception means, for receiving a request for content registration from a content provider that provides content;
>
> identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to the content provider; and
>
> a content ledger database, for storing information related to said identifier provided said content provider.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Gerace	US 5,848,396	Dec. 8, 1998

The following rejections are before us for review:

1. Claims 3-5, 24, and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by Gerace.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Gerace discloses the limitations appearing in independent claim 3 which have been argued as missing by the Appellants.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. Gerace discloses a computer network method for targeting an audience based on psychographic or behavioral profiles of the end user. Using the profile, advertisements are displayed to the end users. (Abstract).

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[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Gerace discloses that a company or sponsor can open an account with the program administrator. The program administrator then obtains the sponsor information and forms a corresponding Sponsor Object. The sponsor information may include advertising information. Col. 17:57-62.

FF3. Gerace discloses that the program administrator takes the sponsor information and advertisements places them in Sponsor Objects 33a-d (Col. 17:61-67).

FF4. Gerace discloses that the advertisement object 33d show a "series ID" associated with the advertisement object (Fig. 5D).

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

The Appellants argue that the rejection of claim 3 is improper because Gerace fails to disclose: 1) a content request receptions means, for receiving a request for content registration from a content provider, 2) identifier provision means, to be added to the content that is to be provided to a user terminal, and for providing the identifier to the content provider, and 3) a content ledger database storing information related to the identifier and content provider (Br. 7-8).

In contrast, the Examiner has determined that Gerace discloses all the claimed limitations of claim 3 (Ans.5-7). The Examiner has determined that Gerace discloses: a content request receptions means, for receiving a request for content registration from a content provider in Figs. 5a-d and Col. 3:4-20; identifier provision means, to be added to the content that is to be provided to a user terminal, and for providing the identifier to the content provider at Col. 17:52-18:10; and a content ledger database storing information related to the identifier and content provider at Col. 33:35-34:27. The Examiner sets forth two interpretations of how Gerace discloses the claim limitations in the Answer set forth at pages 7-10.

We agree with the Examiner. The Appellants at page 4 remark how the claimed invention relates to the owners of rights of music downloads, allowing their content to be downloaded for free where the content is compensated by an advertiser who has an advertising identifier inserted in the content. However, claim 3 contains no limitations drawn specifically to music downloads, advertising, or free content. Claim 3 first requires a

> "content registration request reception means, for receiving a request for content registration from a content provider that provides the content."

Gerace discloses a company or sponsor can open an account with the program administrator. The program administrator then obtains the sponsor information and forms a corresponding Sponsor Object. The sponsor information may include advertising information (FF2). Thus in Gerace a content provider (the sponsor) registers (opens an account) with the program administrator and provides content (advertisements) meeting this argued limitation of the claim.

Claim 3 secondly requires

> "identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to the content provider."

Note that a statement in an Appeal Brief that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See 37 § C.F.R. 41.37 (o) (1). Gerace has disclosed that the program administrator takes the sponsor information and advertisements, and places them in Sponsor Objects 33a-d (FF2, FF3). Gerace has also disclosed that the advertisement objects 33d show a "series ID" associated with the advertisement object (FF4) which would be necessary for keeping records of hits to the advertisement on the website. Thus here, Gerace discloses an identifier (series ID) added (associated) with content (advertisements) meeting the cited limitation argued by the Appellants.

Claim 3 thirdly requires

> "a content ledger database, for storing information related to said identifier provided said content provider."

Gerace has disclosed that the advertisement objects 33d show a "series ID" associated with the advertisement object (FF4) which would serve as database with the content (advertisement) and information related to the identifier (series ID) thus meeting this argued limitation presented by the Appellants.

For these reasons the rejection of claim 3 is sustained. The Appellants have presented no separate arguments for claims 4-5, 24, and 31 and the rejection of these claims is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 3-5, 24, and 31 under 35 U.S.C. § 102(b) as anticipated by Gerace.

DECISON

The Examiner's rejection of claims 3-5, 24, and 31 is sustained.

AFFIRMED

MP

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